

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte GARY L. BOLDT

---

Appeal No. 1999-2369  
Application 08/674,911

---

ON BRIEF

---

Before STAAB, MCQUADE, and BAHR, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Gary L. Boldt appeals from the final rejection of claims 1 through 11, 13, 15, 24 through 31, 33, 35, 43 and 44. Claims 12, 14, 16 through 18, 32, 34 and 36 stand objected to as depending from rejected base claims. Claims 19 through 23, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

Appeal No. 1999-2369  
Application 08/674,911

The subject matter on appeal relates to "door frame kits  
to be assembled into door frames [and] to door frames  
assembled from

such kits" (specification, page 1). Independent claim 1 and  
its  
dependent claims 2 through 11, 13 and 15 are drawn to a door  
frame kit and independent claim 24 and its dependent claims 25  
through 31, 33, 35, 43 and 44 are drawn to a door frame  
assembly. A copy of these claims appears in the appendix to  
the appellant's main brief (Paper No. 12).

#### THE PRIOR ART

The references relied upon by the examiner to support the  
final rejection are:

Passovoy	4,236,354	Dec. 2,
1980		
Fast et al. (Fast)	5,572,840	Nov. 12,
1996		

#### THE REJECTIONS

Appeal No. 1999-2369  
Application 08/674,911

Claims 1, 2, 7, 8, 10, 11, 24, 25, 30, 31 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Passovoy.

Claims 3 through 6, 9, 26 through 29 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Passovoy.

Claims 13, 15, 33 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Passovoy and Fast.

Attention is directed to the appellant's main, reply and supplemental reply briefs (Paper Nos. 12, 16 and 18) and to the examiner's answer (Paper No. 13) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1, 2, 7, 8, 10, 11, 24, 25, 30, 31 and 43 as being anticipated by Passovoy

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the

reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Passovoy discloses a door frame assembly 10 for installation within an opening 14 in a building wall 16. The assembly 10 includes a top frame member 19 and two side frame members 18, 20 formed of identical metal extrusions. Each extrusion consists of a central web 26 adapted to span the width of the wall 16 and a pair of side flanges 27, 28 adapted to extend around the edges of the wall 16 (see Figure 2). Each extrusion also includes a plurality of slots extending along its entire length for variously receiving and positioning hinge plates 52, cover plates 58, a strike plate 24 and door stop pads 40.

Independent claims 1 and 24 recite a door frame kit and assembly, respectively, comprising a top and two side members for "attachment to building members which define a door opening." These claims also require each of the top and two side members to comprise an elongate extruded metal structure having a cavity therein and a substrate received in the cavity.

In rejecting claims 1 and 24 under 35 U.S.C. § 102(b), the examiner has found (see page 3 in the answer) that Passovoy's top and side metal extrusions meet the claim limitations relating to the elongate extruded metal structures having cavities therein and that Passovoy's building wall 16 meets the claim limitations relating to the substrates received in the cavities. The examiner explains with respect to the substrate limitations that "[t]he applicant has not provided language in the claims to suggest the '*substrates*' as not being part of a wall or a separate entity from a building" (answer, page 6).

As indicated above, however, claims 1 and 24 do contain language distinguishing the substrates from building members which define a door opening. Given the distinctions drawn by the claims between the substrates and such building members, a person of ordinary skill in the art would not view Passovoy's building wall 16 as meeting the substrate limitations. Since Passovoy does not disclose any other structure meeting these limitations, the examiner's determination that it constitutes

Appeal No. 1999-2369  
Application 08/674,911

an anticipatory reference with respect to the subject matter recited in claims 1 and 24 is unsound.

Therefore, we shall not sustain the standing 35 U.S.C.

§ 102(b) rejection of claims 1 and 24, or of dependent claims 2, 7, 8, 10, 11, 25, 30, 31 and 43, as being anticipated by Passovoy.

II. The 35 U.S.C. § 103(a) rejection of claims 3 through 6, 9, 26 through 29 and 44 as being unpatentable over Passovoy and the 35 U.S.C. § 103(a) rejection of claims 13, 15, 33 and 35 as being unpatentable over Passovoy and Fast

In addition to not disclosing a door frame kit or assembly comprising substrates of the type recited in independent claims 1 and 24, Passovoy also would not have suggested same to one of ordinary skill in the art. Fast's disclosure of a window frame having a hinged nailing strip does not cure this deficiency.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 3 through 6, 9, 26 through 29 and 44 as being unpatentable over Passovoy or the standing 35

Appeal No. 1999-2369  
Application 08/674,911

U.S.C. § 103(a) rejection of claims 13, 15, 33 and 35 as being unpatentable over Passovoy and Fast.<sup>1</sup>

### III. Additional matter for consideration

Upon return of the application to the technology center, the examiner should consider reevaluating the patentability of the appellant's claims in view of the other prior art references of record. By way of example, U.S. Patent No. 4,531,337 to Holdiman appears to be particularly relevant to the subject matter recited in appealed claims 1 and 24.

---

<sup>1</sup> The subject matter recited in appealed claims 27 and 28, as well as in objected to claims 17 and 18, is not consistent with the underlying specification. More specifically, the specification describes an extruded metal wall thicknesses of at least about 0.03 inch (see pages 5, 10 and 11) as opposed to the at least about 0.02 inch thicknesses recited in claims 27 and 28. In addition, the description of Figure 7 in the specification (see pages 13 and 14) does not provide clear antecedent basis (see 37 CFR § 1.175(d)(1)) for much of the terminology set forth in claims 17 and 18 which presumably read on the Figure 7 embodiment. These discrepancies are deserving of correction.

Appeal No. 1999-2369  
Application 08/674,911

SUMMARY

The decision of the examiner to reject claims 1 through 11, 13, 15, 24 through 31, 33, 35, 43 and 44 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
	)	
	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	



Appeal No. 1999-2369  
Application 08/674,911

JPM/kis  
THOMAS D. WILHELM  
100 W. LAWRENCE  
THIRD FLOOR  
APPLETON, WI 54911